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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/987,468	12/10/1997	HEINRICH GERS-BARLAG	BEIERSDORF	6313

27384 7590 04/20/2005

NORRIS, MCLAUGHLIN & MARCUS, PA  
875 THIRD STREET  
18TH FLOOR  
NEW YORK, NY 10022

EXAMINER
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LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/987,468

Applicant(s)

GERS-BARLAG ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Acknowledgment is made of the reply filed 1/10/05. Claims pending are 31-48.

#### ***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The rejection of Claims 31, 32, 36-41 and 45-48 under 35 U.S.C. 103(a) as being unpatentable over Allard et al. (US 5,616,331) in view of either Kumano et al. ("Studies of water-in-oil (w/o) emulsion stabilized with amino acids or their salts", J. Soc. Cosmet. Chem., 28, No. 5, 285-314, 1977) or Robinson et al. (US 5,306,485) is maintained for the reasons of the record.
3. The rejection of Claims 33-35 and 42-44 under 35 U.S.C. 103(a) as being unpatentable over Allard et al. (US 5,616,331) in view of either Kumano et al. ("Studies of water-in-oil (w/o) emulsion stabilized with amino acids or their salts", J. Soc. Cosmet. Chem., 28, No. 5, 285-314, 1977) or Robinson et al. (US 5,306,485) as applied to claims 31, 32, 39 and 41 above, and further in view of either Billia et al. (US 5,486,353) or Robinson et al. (US 5,306,485) is maintained for the reasons of the record.

#### ***Response to Arguments***

4. Applicant's arguments filed 1/10/05 have been fully considered but they are not persuasive. The Applicant argues: "There absolutely nothing in the combination of Allard and the secondary references that would have led persons skilled in the art to ignore the fact that Allard was directed to oil-in-water emulsions, and to solving

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problems associated therewith, and to employ Allard's solution to such problems in the context of water-in-oil emulsions with a reasonable expectation of success". See p. 4 of the reply. In response, the emulsions taught by Allard contain the same ingredients as claimed in the instant claims. The emulsions of Allard are used for the same purpose as the claimed emulsions, i.e. as cosmetic sunscreens. There is nothing **in the body** of the instant claim 31 that distinguishes the composition claimed therein from the compositions of Allard. Both o/w and w/o emulsions as well as multiple emulsions are very well known in the art of sunscreen cosmetic compositions. Furthermore, the secondary references (Kumano et al. and Robinson et al.) show the superiority of w/o emulsions as compared to o/w for the formulation of cosmetic sunscreens. More specifically, Kumano et al. teach that w/o emulsions are more advantageous to skin than o/w emulsions because they have better skin protecting and moisturizing properties than o/w emulsions. See p. 285. Robinson et al. teach w/o emulsions containing oil-soluble sunscreens provide better suncreening efficiency than o/w emulsions containing oil-soluble sunscreens. See col. 2, lines 33-40. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the emulsions of Allard et al. such that to make w/o emulsions. One having ordinary skill in the art would have been motivated to do this to obtain better skin protection and moisturizing as suggested by Kumano et al. or better suncreening efficiency as suggested by Robinson et al. Therefore, the secondary references provide one skilled in

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the art with the motivation and reasonable expectation of success for formulating Allard's compositions into w/o emulsions.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

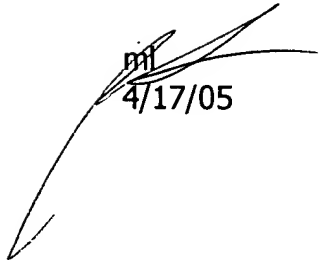
The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SHELLEY A. DODSON  
PRIMARY EXAMINER



4/17/05